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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,516	12/21/2001	Sebastian Bohm	TGZ-001CRCE2	3707
959	7590	03/30/2006	EXAMINER	
LAHIVE & COCKFIELD 28 STATE STREET BOSTON, MA 02109			ALEXANDER, LYLE	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/027,516

Applicant(s)

BOHM ET AL.

Examiner

Lyle A. Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 and 24-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims (1-28,58-150) and (1-45) of copending Application No. 10/028,852 and 10/057,354 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to a microfluidic device having a virtual wall.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-22 and 24-41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,877,528. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to a microfluidic device having a virtual wall. This patent is silent to the claimed dimension of the interface port.

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The court decided In re Rose (105 USPQ 237) “ ... the size of the article under consideration which is not ordinarily a matter of invention .” Additionally, it is desirable to make microfluidic devices as small as possible to minimize the volumes of reagents and samples. This minimization saves in the cost of the reagents and conserves the samples for further testing.

It would have been within the skill of the art to modify USP 6,877,528 and have channels and ports in the device meeting the claimed size of the channels and as the dimensions chosen for the channels would not ordinarily be a matter of invention.

***Claim Rejections - 35 USC § 112***

Claims 1-22 and 24-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 15 contain the limitation that the fluid interface port has “a depth equal to a thickness of the side wall and a diameter that is significantly larger than the depth and between about 25 um and about 100 um... “. It is confusing what is the intended diameter of the port. It appears the only concrete limitation is the port has be between 25-100 microns. For the purposes of examination it will be assumed the diameter of the port will be 25-100 microns.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-22 and 24-41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Chow (USP 6,494,230).

Chow teach a device comprising a plurality of microchannels(306) and interfaces ports(310). Column 3 lines 38-67 teach the dimension of the microfluid channels is between 0.1-500 microns. Column 10 lines 41-58 teach the dimensions of the ports are between 30-500 microns which has been read on the claimed fluid port interface having a diameter between 25-100 microns as the claimed virtual wall. Figure (3B) teaches the ports(310) have circular or cylindrical shape. Covering layer(106) has been read on the claimed "cover".

Claims 1-22 and 24-41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Handique et al. (USP 6,130,098).

Handique et al. teach in figure 3(A-B) a microfluidic apparatus comprising a microchannel (labeled "1") and a fluid interface port(70). Column 7 lines 53-63 teach the width of the channel is between 20-1000 nanometers which has been read on the claimed fluid port interface having a diameter between 25-100 microns as the claimed virtual wall.

Claims 1-22 and 24-41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fuchs (USP 5,757,482).

Fuchs teaches a microfluidic device comprising a microchannel(12) and a fluid interface port(24). Figure 1 illustrates the diameter of the port coincides with the diameters of the channels(12). Column 5 lines 21-28 teach the dimensions of the

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channels are between 10 and 1000 microns which has been read on the claimed fluid port interface having a diameter between 25-100 microns as the claimed virtual wall.

***Response to Arguments***

Applicant's arguments with respect to claims 1-22 and 24-41 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lyle A Alexander  
Primary Examiner  
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